

REMARKS

In response to the Office Action dated December 10, 2002, claims 1, 10, 12, 14-15, and 21-26 have been amended and new claims 30 and 31 have been added. Claims 1-31 are in the application and stand rejected. Reconsideration is respectfully requested.

Submission of IDS

The Examiner has noted that certain references cited in the specification were not considered during examination of the application. An IDS specifically listing these references for consideration is submitted concurrently with this response.

Rejection of Claims 1-21:

The Examiner has rejected claims 1-5, 7, 10, 12-13, 15-16, and 18 as being anticipated by U.S. Patent No. 5,714,098 to Potter. Claims 6, 8-9, 11, 14, 17, 19-21 stand rejected as being obvious over Potter.

Potter is directed to a system wherein a customer selects shoes of approximately the correct size and then the shoes are re-formed to more closely match an actual measured size of the customer's feet. The inventory of stock shoes "incorporate a moldable fit component" that allows the length and width of the shoes to be adjusted by molding. (Col. 4, lines 12-37). The moldable "fit-strip 33" is arranged around the periphery of the shoe and the shoe is provided with its normal cushioning 23. (Col. 5, line 46 – Col. 6, line 21).

As noted by the Examiner, Potter briefly notes that footwear inserts separate from the footwear can be molded and inserted into the shoe. Applicants disagree with the Examiner, however, that Potter teaches providing a "flat inner foot receiving surface" as recited in claims 1,

12, and 15, and, in particular, a flat surface having no arch support or otherwise normally provided inner cushioning, as recited in claims 1, 12 and 15, and amended.

According to its ordinary definition, an “insole” is the inside sole of a shoe, and more specifically, is “an extra, removable inside sole put in for comfort or waterproofing.” (Webster’s New Twentieth Century Dictionary Unabridged, 2nd Ed. 1983). Potter does not specify the composition of the insoles, other than that they should be moldable so that the length and/or width of the fit can be adjusted. Indeed, Potter addresses molding of insoles only briefly and contains no teaching or suggestion to provide an inventory of shoes having all arch support or otherwise normally provided inner cushioning removed so that the foot receiving surface is flat. As such, the Examiner’s contentions that Potter discloses this aspect of the invention, as presently claimed, is based on hindsight. Accordingly, the rejection of independent claims 1, 12, and 15 as being anticipated by Potter is improper and should be withdrawn.

The Examiner has rejected claim 10 as being obvious over Potter on the grounds that Potter discloses measuring at least one width for each foot. Potter teaches that foot width can be measured using a conventional device that provides for at least nine different widths. (See, e.g., Potter, Col. 1, lines 29-31). In contrast, claim 10, as amended, recites the step of measuring “one of only three foot widths for each foot.” (This is discussed in paragraph 15 of the specification). Potter does not disclose measuring “only” one of three specified foot widths. Accordingly, the rejection of claim 10 as being anticipated by Potter has been traversed and should be withdrawn.

Similarly, with respect to claims 14 and 21, which depend from independent claims 12 and 15, respectively, the Examiner contends that it would have been obvious to use such a measurement device for measuring width. However, claims 14 and 21, as amended, recite a system wherein the measuring device has “indicia for measuring one of only three foot widths.”

To the extent that Potter suggests providing a measuring device, it would have at least the nine specified widths indicated and, to the further extent that Potter suggests providing a device that has different numbers of indicated measurements, Potter teaches that the standard width increments are not fine enough, (Col. 1, lines 40-43), and so such a device would have even more measurement indicia.

Accordingly, Potter does not teach or suggest providing a measurement device that has indicia for measuring one of “only” three foot widths as recited in claims 14 and 21, and in fact, teaches against reducing the number of indicia to only three. Accordingly, the rejection of claims 14 and 21 as being obvious over Potter has been traversed and should be withdrawn.

The Examiner has rejected claim 11 over Potter on the grounds that it would have been obvious to allow selection of sizes over the Internet. Applicants respectfully disagree. The method of Potter requires the customer to try on various shoes to find the closest fit, and then that these shoes be further reformed to better fit the user. (See, e.g., Potter, Abstract). Such individualized custom fitting is simply not appropriate for an Internet-based ordering system wherein immediate sizing feedback is not possible. Accordingly, it would not have been obvious to implement the custom fitting method of Potter over the Internet, as recited in claim 11, and Applicants respectfully request that the rejection of claim 11 be withdrawn.

Rejection of Claims 22-28:

Claims 22-24 stand rejected as being obvious over U.S. Patent No. 2,162,916 to Hyland in view of U.S. Patent No. 5,822,223 to Genest. The Examiner contends that Hyland discloses a device having reference indicia as recited in the claims but without second references and indicia for a right foot. The Examiner further contends that Genest discloses a symmetrical apparatus

and that it would be obvious to modify the arrangement of Hyland to maintain symmetry. Applicants respectfully disagree.

To measure a foot width using the system of Hyland, one side of the foot is pressed against a side of the device and a sliding bar is moved until it touches the other side of the foot. Only one width slider is provided and, to measure the width of both the left and right foot, the measuring device must be turned around. The system of Genest has the same general design for a width slider. As is clearly indicated in Fig. 1 of Genest, separate right and left heel cups are provided. Like Hyland, the Genest device is not symmetric and must be turned around to measure both feet.

In contrast, claim 22, as amended, recites a device for measuring foot size that comprises “second and third indicia on the surface for indicating the width of the foot, the second indicia comprising a series of marking spaced at respective predetermined distances to the right of a center axis of the surface, the third indicia comprising a corresponding series of markings spaced at the respective predetermined distances to the left of the center axis, corresponding pairs of markings from the second and third indicia indicating the width of the foot when the foot is centered on the surface.” (This aspect of the invention is discussed at paragraph 40 of the application. One embodiment, that using three corresponding pairs of parallel lines, is shown in Fig. 3A.) Because the second and third indicia are spaced outwards in correspondingly equal amounts to the left and right from a center axis of the device, the width of either of a customer’s foot can be determined by placing the foot on the device and centering it between corresponding lines of the second and third indicia. This arrangement avoids having to turn the device around when measuring the left and the right foot, a step that is necessary in the prior art devices identified by the Examiner. This configuration also allows for a simplified design of the arch

height measurement device (discussed below) because the arch height measurement mechanism does not need to compete with a width slider.

In addition, Hyland discloses only a single mechanism for measuring the height of the arch. In contrast, claim 22, as amended to emphasize this feature, recites “a first mechanism for measuring the height of the arch of the left foot; and a second mechanism opposing the first for measuring the height of the arch of the right foot.” Although the Examiner contends that it would have been obvious to provide two such opposing devices “to maintain symmetry”, Applicants respectfully disagree because neither Hyland nor Genest have an appropriate symmetry to maintain. Instead, both require that left and right foot measurements can be made by turning the device around. Providing two arch measurement devices, as suggested by the Examiner, would require entirely redesigning the Hyland device. Moreover, Genest does not disclose any arch measurement device and so does not cure the deficiency of Hyland in this regard.

Because neither Hyland nor Genest teach or suggest completely eliminating the width slider and replacing it with the indicia as recited in claim 22 or providing two opposing arch height measuring mechanisms, the rejection of claim 22 as being obvious over Hyland and Genest has been traversed.

Dependent claim 23 recites that the second and third indicia each comprise only three lines. There is no teaching or suggestion in Hyland or Genest to provide lines as recited in claim 22 and nothing whatsoever that would limit the number of such lines to three. Accordingly, for this additional reason, the rejection of claim 23 has been traversed.

Dependent claim 24 recites that the first and second mechanisms each comprise a wedge movable towards and away from the arch of a foot and indicia associated with each wedge

indicating the height of the arch based upon the position of the wedge when in contact with the arch of the foot. The wedge of Hyland does not measure arch height based on the wedge position when the wedge itself is in contact with the arch. Instead, Hyland teaches to use a number of wedges as camming members which are used to raise and lower “feelers 31” that contact the arch of the foot. Because the wedge in Hyland is not used to directly measure the arch height as recited in claim 24, the rejection of this claim as being obvious over Hyland and Genest has been traversed for this additional reason.

For these reasons, the rejections of claims 22-24 have been traversed and should be withdrawn.

Finally, the Examiner has rejected claims 25-26 and 28-29 as being obvious over U.S. Patent No. 5,640,779 to Rolloff and claim 27 as being obvious over Rolloff in view of U.S. Patent No. 5,237,520 to White.

The Examiner admits that the system of Rolloff does not contain the indicia as recited in the claims but maintains that it would be obvious to add this feature. Applicants respectfully disagree. As with the systems of Hyland and Genest, the system of Rolloff measures the foot size with reference to the placement of the foot against one side of the measuring device. (Rolloff, Col. 8, lines 11-16). Thus, only for the sake of argument, to the extent it were obvious to form indicia on the surface of the Rolloff device, any indicia related to foot width would be based on width from a side (corresponding roughly to the width slider of Hyland and Genest). There is no teaching or suggestion to provide such an indicia and nothing whatsoever to suggest forming second and third indicia symmetrically about a center axis as recited in claim 25. The White patent discloses a system in which an image of a footprint is captured and does not cure the deficiency of Rolloff.

Accordingly, Applicants have traversed the rejection of claim 25 and requests that it be withdrawn. Claims 27 –29 are allowable for at least the same reasons.

Dependent claim 26 recites that the second and third indicia each comprise only three lines. For the same reasons as discussed with respect to claim 23, Applicants submit that claim 26 further distinguishes over the cited references and the rejection should be withdrawn for this additional reason.

New Claims 30 and 31

The application has been amended to add new claims 30 and 31, depending from claims 23 and 26, respectively, and reciting that the lines in the indicia are substantially parallel. This limitation was originally recited in claims 23 and 26. Applicants submit that these claims are allowable over the cited art for at least the same reasons as discussed above with respect to parent independent claims 22 and 25.

CONCLUSION

Each and every issue raised by the Examiner has been addressed by way of the above amendments and remarks and withdrawal of the rejections is respectfully requested. However, should the Examiner believe that direct contact with the Applicants' representative would advance the progress of this application, the Examiner is invited to telephone the undersigned at the number below.

Date:

5.16.03

Respectfully submitted,



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